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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/703,858	11/01/2000	Brian Kevin Daly	2000-0063	3715

24197 7590 06/16/2003  
KLARQUIST SPARKMAN, LLP  
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PORTLAND, OR 97204

EXAMINER

GARY, ERIKA A

ART UNIT	PAPER NUMBER
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2681

DATE MAILED: 06/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/703,858

Applicant(s)

DALY, BRIAN KEVIN

Examiner

Erika A. Gary

Art Unit

2681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 November 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8 is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 February 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to because in fig 4b, in boxes 66 and 70, "to MS" should be "to MSC" and in fig. 4c, box 86, "accept MSC" should be "accept to MSC". A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Chatterjee et al., US Patent Number 6,282,421 (hereinafter Chatterjee).

Regarding claim 1, Chatterjee discloses a method of activating a mobile station for communicating with a telecommunications network, comprising the steps of: (a) in a first registration, providing the mobile station with a permanent mobile station ID [fig. 5]; (b) in a second registration, receiving the permanent mobile station ID from the mobile

station [fig. 6]; and (c) communicating programming data to the mobile station [figs. 5, 6].

Regarding claim 2, Chatterjee discloses the first registration comprises the steps of receiving a temporary activation mobile station ID from a mobile station; verifying the temporary activation mobile station ID; and communicating a permanent mobile station ID to the mobile station [fig. 5; col. 9: line 59 – col. 10: line 28].

Regarding claim 3, Chatterjee discloses the second registration comprises the steps of: receiving the permanent mobile station ID from the mobile station; verifying the permanent mobile station ID; and communicating programming data to the mobile station [fig. 6; col. 10: lines 29-51].

Regarding claim 4, Chatterjee discloses a method of activating a mobile station for communicating with a telecommunications network, comprising the steps of: of receiving a temporary activation mobile station ID from a mobile station; verifying the temporary activation mobile station ID; communicating a permanent mobile station ID to the mobile station [fig. 5; col. 9: line 59 – col. 10: line 28]; receiving the permanent mobile station ID from the mobile station; verifying the permanent mobile station ID; and communicating programming data to the mobile station [fig. 6; col. 10: lines 29-51].

Regarding claim 5, Chatterjee suggests receiving the temporary activation mobile station ID (it is inherent in the art to also send the ESN) of the mobile station at a mobile switching center, and sending a registration notification to an over-the-air activation function; and sending a registration notification containing the permanent mobile station

ID from the over-the-air activation function to the mobile switching center [fig. 5; col. 9: line 59 – col. 10: line 28].

Regarding claim 6, Chatterjee suggests receiving the permanent mobile station ID (it is inherent in the art to also send the ESN) from the mobile station at the mobile switching center; and the mobile switching center sending a registration notification to a home location register assigned to the permanent mobile station ID [fig. 6; col. 10: lines 29-51].

#### ***Allowable Subject Matter***

4. Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 8 is allowed. Prior art has not been found that suggests or renders obvious the limitations steps (f) – (i) of the method in combination with steps (a) – (e).

#### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tiedemann, Jr. et al., US Patent Number 6,381,454 disclose a method and system for over-the-air service programming.

Holmes, US Patent Number 6,490,445 discloses a customer activation system for a cellular network.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erika A. Gary whose telephone number is 703-308-0123. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne Bost can be reached on 703-305-4778. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4750 or to the 2600 Customer Service Office at 703-306-0377.

**Any response to this action should be mailed to:**


Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

(703) 872-9314 (for informal or draft communications, please label "PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive Arlington, VA., Sixth Floor (Receptionist).

EAG  
June 12, 2003

  
ERIKA GARY  
PATENT EXAMINER